



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
PO Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10,072,734	02.05.2002	David R. Hembree	96-750.3	2695
22823	7590	06 11 2003		
STEPHEN A GRATTON			EXAMINER	
THE LAW OFFICE OF STEVE GRATTON			KARLSEN, ERNEST F	
2764 SOUTH BRAUN WAY				
LAKWOOD, CO 80228			ART UNIT	PAPER NUMBER
			2829	

DATE MAILED: 06/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

	Application No.	Applicant(s)
	10/072,734	HEMBREE ET AL.
	Examiner Ernest F. Karlsen	Art Unit 2829

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 March 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 44-53 and 74-90 is/are pending in the application.
- 4a) Of the above claim(s) 44-53, 74-76 and 83-90 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 77-82 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 February 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3_7</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2829

1. Applicant's election with traverse of species 5, claims 77-82, in Paper No. 8 is acknowledged. The traversal is on the ground(s) that insufficient information was provided to demonstrate why the species are mutually exclusive. This is not found persuasive because applicant argues that claim 77 is generic to that which is claimed in claim 83. The examiner finds claim 77 to have limitations not in claim 83 and vice versa. Lines 1-5 of claim 77 appear to be *claim 83. Lines 6-16 & 18* equivalent to lines 1-6 of claim 77 do not appear equivalent to lines 7-14 of claim 83. Lines 17 and 18 of claim 77 definitely do not appear equivalent to lines 15-18 of claim 83. Lines 19 and 20 of claim 77 are identical to lines 19 and 20 of claim 83.

Lines 19 and 20 of claim 77 are identical to lines 19 and 20 of claim 83. Claim 77 cannot be generic to that which is claimed in claim 83 because claim 83 does not include all the steps of claim 77. The independent claims of the group of claims 44-53 and 74-76 are more divergent from each other and from claims 77 and 83 than 77 and 83 are divergent from each other. Admission on the record that each of the species is not patentably distinct from any of the remaining species will result in rejoicing and examination of all species.

2. Claims 44-53, 74-76 and 83-90 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

3. Claims 77-82 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the

Art Unit: 2829

art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

There is no original disclosure for "spring loaded electrical connectors."

4. Claims 77-82 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what parts of the disclosed apparatus would be used in performing the claimed method. A reading of at least claim 77 with respect to a figure or to figures of the drawings is requested. It appears that limitations beginning at lines 6, 9 and 13 of claim 77 are reclaiming that which was claimed in the limitation beginning at line 3 of claim 77. The word "pogo" in claim 79 is improper since it is a trademark.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

6. (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35

Art Unit: 2829

U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 77-82 are, insofar as understood, rejected under 35 U.S.C. 102(e) as being fully anticipated by Nakata et al.

Figures 1a and 1b of Nakata et al show a mounting plate 11 and a substrate 9 on the mounting plate 11 where the substrate 9 has contact members 14 to contact a wafer. The plate 12 is an electrical connector which is elastically pressed against the wafer being tested. Because applicant has no proper disclosure for "spring loaded electrical connectors" the "spring loaded" part is given no patentable weight. The use of the word "pogo" in claim 79 is improper because it is a trademark. The probes of Nakata et al penetrate as claimed in claim 80. The limitations of claims 79, 81 82 are inherent in Nakata et al.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. ^{Wen} ~~Wen~~ et al '326 is cited to show additional apparatus and method similar to that disclosed.

Karlsen/ds

06/03/03



ERNEST KARLSEN
PRIMARY EXAMINER